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REMARKS

Reconsideration of the rejections set forth in the Office action dated 10/20/2004 is respectfully requested in view of the following remarks.

The Specification and Abstract

The specification has been amended to show references to the JAVA programming language as being a trademarked name.

A replacement Abstract has been provided. The replacement Abstract does not introduce new matter into the specification. The first two sentences of the replacement Abstract are paraphrases of language from the amended independent claims. The third sentence is a paraphrase of amended claims 4 and 8. The fourth sentence is a paraphrase of claim 49. The last sentence is taken from the specification at page 23, line 19.

The Claims

Prior to entry of this amendment, claims 1 – 9, 11 – 23, 25 – 37 and 39 -45 were pending in this application, including independent claims 1, 15 and 29, for a total of 42 claims.

In this amendment, independent claims 1, 15 and 29 have been amended. Support for the newly-added limitations in these claims may be found in the specification at pages 24, 32 – 33 and 38 – 40. The limitation of storing the e-mail message in a database has been moved from the independent claims to amended dependent claims 2, 16 and 30. The limitations of determining a recipient email address and transmitting the email message have been moved from the independent claims to new claims 49 – 51. Dependent claims 4, 8, 9, 12, 13, 18, 22, 23, 26, 27, 32, 36, 37, 40 and 41 have been amended to conform the language of those claims to the language in the amended independent claims.

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Claims 46 – 48 have also been added. Support for the limitations in these claims may be found in the specification at pages 32 – 34 and 39, and in Figures 14 - 18.

Also in this amendment, claims 7, 14, 21, 28, 35 and 42 have been canceled.

After entry of this amendment, claims 1 – 6, 8, 9, 11 – 13, 15 – 20, 22 , 23, 25 – 27, 29 – 34, 36, 37, 39 -41 and 43 – 51 are pending in this application, including amended independent claims 1, 15 and 29, for a total of 42 claims.

Objection to the Specification

The specification is objected to in paragraphs 8 – 9 of the Office Action for failing to indicate that JAVA is a trademarked name. Appropriate correction has been made to every reference to the JAVA programming language found in the specification, except in the cases where the language is referred to as part of an example of a string of code. See, for example, the paragraph at page 13, line 19, where the reference to the JAVA objects has been changed to show "JAVA" in capital letters but the examples of code strings that contain the term "java" have not.

It is believed that each and every rejection to the specification has been addressed and corrected, and it is respectfully submitted that the objections to the specification have been overcome.

35 U.S.C. 103(a)

In the Office Action, claims 1 – 9, 11 – 23, 25 – 37 and 39 -45 were rejected, in paragraph 8, under 35 U.S.C. § 103(a) as being unpatentable over Biliris et al. (US 6,442,546), hereafter Biliris, in view of U.S. Patent 6,775,689 issued to Raghunandan (hereafter Raghunandan.). This rejection is respectfully traversed, in view of the amendments made to the claims and the following arguments. Neither reference alone or in combination teaches or suggests the limitations of the amended independent claims.

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While the discussion that follows refers to claim 1, it applies equally to independent claims 15 and 29.

The method of operating an e-mail invoked application server of amended independent claim 1 receives an incoming e-mail message from a sender, the incoming e-mail including content and a destination address having an address format. The method determines which application of a plurality of applications available on the e-mail-invoked application server will accept the incoming e-mail for processing by comparing the address format of the destination address to acceptable address formats defined by the applications. The incoming e-mail is refused when it is determined that no application will accept the incoming e-mail for processing. When the address format of the destination address is determined to be one of the acceptable address formats defined by at least one application, the at least one application is invoked to process the content of the incoming e-mail message.

The Biliris Reference

Biliris teaches a messaging system that includes a plurality of messaging entities, such as messages, folders and users, a plurality of attributes associated with the messaging entities, and a plurality of applications. A core messaging infrastructure stores and manages messaging attributes. (Biliris, Abstract.) Each application is operable to examine and modify at least some of the messaging entities and attributes. An application selection device is operable to select an application to be invoked based on values of the examined messaging entities and attributes. An application invocation device invokes the selected application. (Biliris, col. 1, lines 52 – 60.)

Biliris explicitly teaches that applications are selectively invoked based on the state of the messaging system, which is defined as the set of values of all the entities and attributes in the messaging system. (Biliris, col. 7, lines 10 – 16.) Thus, Biliris does not appear to teach determining which application of a plurality of applications available on the e-mail-invoked application server will accept the incoming e-mail for processing by comparing the address format of the destination address of the incoming e-mail to a plurality of acceptable address formats defined by the applications, and invoking an

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application when the address format of the destination address is determined to be one of the acceptable address formats defined by at least one application.

The Raghunandan Reference

Raghunandan teaches a method, apparatus and program product for restructuring email messages for transmission to a plurality of recipients by providing transmission control directives and email content segment identifiers, supplied by the user, parsing the directives and email contents, expanding aliases wherever necessary and applying the directives to restructure the email contents by sending selected segments to selected recipients. (Raghunandan, Abstract.)

The email system receives the email message from the user, including identified segments in the email contents as well as transmission control directives in the email header, which define identified recipients for each identified segment. The email system parses the message to identify each segment as well as the list of recipients for each segment. The email system then constructs customized email messages for each list of recipients, in accordance with the transmission control directives by excluding those segments which the recipients are not required to receive. The messages are then transmitted to each of the recipients in each of the lists. (Raghunandan, col. 6, lines 37 – 51, Figs. 1 and 4.)

The Raghunandan reference provides several examples of the features of the technique for restructuring email messages. In the discussion of the implementation details of these examples, Raghunandan discloses how to modify the algorithms of an existing email system to implement the new techniques. These details include the inclusion of new fields in the e-mail header structure for identifying recipient lists for each segment in the email content, and new fields in the e-mail body structure to associate text or attachments with each segment. (Raghunandan, col. 8, lines 50 – 60.) In a second example, changes are required to the To:, CC:, Bcc: and Group: value types to include segment order separated by commas, in order to select more appropriate recipients who are part of a complex alias hierarchy . (Raghunandan, col. 10, lines 4 – 7 and 53 – 57.)

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It appears that the teachings in the Raghunandan reference have no direct relevance to the limitations in amended independent claim 1. Raghunandan does not appear to teach determining which application of a plurality of applications available on the e-mail-invoked application server will accept an incoming e-mail for processing by comparing the address format of the destination address of the incoming e-mail to a plurality of acceptable address formats defined by the applications, and invoking an application when the address format of the destination address is determined to be one of the acceptable address formats defined by at least one application.

For the foregoing reasons, is believed that independent amended claims 1, 15 and 29 are patentably distinct over and are not obvious in view of the Biliris and Raghunandan disclosures, and are believed to be in condition for allowance. Insofar as claims 2 – 6, 8, 9, 11 – 13, 16 – 20, 22 , 23, 25 – 27, 30 – 34, 36, 37, 39 -41 and 43 – 51 are concerned, these claims include the limitations of and depend from now presumably allowable claims 1, 15 and 29 and so are also believed to be in condition for allowance.

Dependent Claims 46 -48.

Dependent claim 46 recites a method of claim 1 wherein one of the acceptable address formats defined by the plurality of applications is data@host.domain, wherein domain indicates a domain name of the e-mail-invoked application server, host indicates an application available in the domain, and data indicates information provided by the sender. The Biliris disclosure makes no reference to any specific e-mail address format, and in particular, makes no reference to an application defining an acceptable e-mail address format.

For the foregoing reasons, is believed that dependent claims 46 – 48 are patentably distinct over and are not obvious in view of the Biliris disclosure, and are believed to be in condition for allowance.

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Dependent Claims 3, 17 and 31.

The Office Action rejects dependent claims 3, 17 and 31 as being taught in Biliris at column 7, lines 1 – 38 and in Figure 11. Dependent claim 3 recites a method of claim 1 wherein the at least one application is selected from the group consisting of a lead tracking application, a job requisitioning application, an event planning application, a task list management application, a project management application, and an accountability application. As noted above, the Biliris disclosure discusses that applications are selectively invoked based on the state of the messaging system, which is defined as the set of values of all the entities and attributes in the messaging system. (Biliris, col. 7, lines 10 – 16.) This entire section and Figure 11 teach the invocation of applications generally; there is no teaching here of any specific application.

For the foregoing reasons, is believed that dependent claims 3, 17 and 31 are patentably distinct over and are not obvious in view of the Biliris disclosure, and are believed to be in condition for allowance.

Rejections of Dependent Claims Based on "Routine Skill in the Art" Theory

The Office Action acknowledges that limitations in dependent claims 11, 25, 39, 43, 44 and 45 are not taught in Biliris. In each of these rejections, the Office Action relies on a person of ordinary skill in the art at the time the invention was made for both the teaching of the claim element and the motivation to modify the messaging system disclosed in Biliris to make the asserted combination. Referring to the rationale stated for now deleted claims 7, 21 and 35, the Office Action suggests that implementation of each of the limitations in claims 11, 25, 39, 43, 44 and 45 would have been obvious to one of ordinary skill in the art because it requires only routine skill in the art, citing *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Applicants note that, according to MPEP § 2144.04, the Seid case held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. It is respectfully submitted that the limitations of the claims rejected in the Office Action

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under this theory do not deal with matters related to ornamentation only. It is respectfully suggested that n e-mail attachment and invoking an application in response to an e-mail attachment are not merely "ornamental" features of the subject invention.

For the foregoing reasons, is believed that dependent claims 11, 25, 39, 43, 44 and 45 are patentably distinct over and are not obvious in view of the Biliris disclosure, and are believed to be in condition for allowance.

Rejections of Some Dependent Claims Fail to State a Prima Case

The Office Action acknowledges that limitations in dependent claims 4, 18, 32, 8, 22, 36, 9, 23 and 37 not taught in Biliris. In each of these rejections, the Office Action relies on a person of ordinary skill in the art at the time the invention was made for both the teaching of the claim element and the motivation to modify the messaging system disclosed in Biliris to make the asserted combination. In the case of each of these claim rejections, the Office Action suggests that making the modification stated in the dependent claim to the Biliris email messaging system would be beneficial if the application invoked in the Biliris messaging system became dormant, quiet or stalled. See the Office Action, paragraphs 16, 20 and 21.

To follow that logic further using the limitation of claim 4, the Office Action seems to suggest that when an application in the messaging system in Biliris, invoked based on the state of the messaging system, became dormant, it would be obvious to a person of ordinary skill in the art to modify the messaging system so that the at least one application invoked by the incoming email generates a reply to the incoming e-mail message to advance the processing of a task. This logic clearly fails for two reasons: there is no explicit teaching in Biliris that the application is invoked by the incoming email, and, if the application is dormant, how could it generate a reply to advance the processing of a task?

It is respectfully suggested that each of these rejections of the dependent claims is based on equally vague, general and unsupported reasoning and do not constitute *prima*

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facie rejections under 35 U.S.C. 103(a). As noted in MPEP § 2143.01 at pages 2100-129 and 2100-131,

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet,* 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.,* 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). ...

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood,* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

For the foregoing reasons, is believed that the Office Action does not state prima facie rejections of dependent claims 4, 18, 32, 8, 22, 36, 9, 23 and 37 and the rejections should be withdrawn as to these claims.

Fee Authorization And Extension Of Time Statement

A fee for an extension of time for one month has been authorized in the accompanying transmittal papers. No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any additional extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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Reconsideration Requested

The undersigned respectfully submits that, in view of the foregoing remarks, the rejections of the claims raised in the Office Action dated February 26, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Daniel B. Curtis
Attorney for Applicants
Reg. No. 39,159
(650) 812-4259
dbcurtis@parc.com